

REMARKS

In response to the above-identified Office Action (“Action”), Applicant traverses the Examiner’s rejection to the claims and seeks reconsideration thereof. Claims 1 and 4-15 are now pending in the present application. In the instant response, no claims are amended, no claims are added and no claims are cancelled.

I. Claim Rejections – 35 U.S.C. §102

In the outstanding Action, the Examiner rejects claims 1, 4, 5, 7 and 13 under 35 U.S.C. §102(b) as being anticipated by U.S. Patent No. 4,818,523 issued to Clarke et al. (“Clarke”). Applicant respectfully traverses the rejection.

It is axiomatic to a finding of anticipation that each and every element of a claim be found within a single reference.

In regard to claim 1, Clarke fails to teach at least the element of “the amount of silicone present in the composition is 2% to 30% by weight.” The Examiner alleges the disclosure of about 0.5%- about 1.5% silicon in Clarke is either within, overlapping or touching 2% and therefore teaches this element. See Action, page 2. Applicant respectfully disagrees with the Examiner analysis.

As an initial matter, Clarke does not recite “about 0.5%-about 1.5%” as stated by the Examiner. Instead, Clarke recites “about 0.5% to 1.5%.” See Clarke, col. 6, line 57.

Moreover, the relevant inquiry with respect to anticipation of a range where the prior art does not disclose a specific example within the claimed range is not whether the prior art range is within, overlapping or touching merely an endpoint of the claimed range as alleged by the Examiner. Instead, the proper inquiry is whether the prior art discloses a range that is within, overlapping or touching the claimed range. See MPEP §2131.03(II). Moreover, even if the answer to this question is yes, anticipation may only be found if the prior art range discloses the claimed range with “sufficient specificity.” See MPEP §2131.03(II).

Appellant respectfully submits when the proper analysis is applied in the instant case, it is clear that the range of “about 0.5% to 1.5%” disclosed in Clarke does not anticipate the claimed range. In particular, a range of “about 0.5% to 1.5%” is defined by endpoints which are less than the claimed range of “2% to 30%” and therefore the range disclosed in Clarke is entirely outside

of the claimed range. Moreover, there is no support in Clarke to increase the recited endpoint of 1.5% so that the range touches, overlaps or falls within the claimed range. As previously pointed out, Clarke discloses an endpoint value of 1.5%, not about 1.5% as alleged by the Examiner. Moreover, Clarke teaches a preferred range of 0.5% to 1.0%. See Clarke, col. 6, line 58. Accordingly, if the end point of 1.5% recited in Clarke may be modified in any manner, and Applicant does not believe this is the case, it may only be to a lesser value such as one between 1.0% and 1.5%. Moreover, even if it were possible to find the prior art range touches overlaps or falls within the claimed range, and Applicant does not believe it is, the Examiner has not satisfied the second requirement by establishing that the prior art range discloses the claimed range with “sufficient specificity” therefore the rejection on this basis must fail.

The Examiner’s analysis is further inconsistent with the case law. For example, in *Atofina v. Great Lakes Chemical Corp.*, Case No. 05-1359, page 15, (Fed. Cir., March 23, 2006), the Federal Circuit held that the claimed molar ratio of between 0.5% and 3% was not anticipated by the range of 0.001% to 1% recited in the prior art. In reaching this decision, the Federal Circuit reasoned that “although there is a slight overlap, no reasonable fact finder could determine that this overlap describes the entire claimed range with sufficient specificity to anticipate this limitation of the claim.” *Id.* The Federal Circuit further characterized the ranges as “different, not the same.” *Id.* Certainly, if a range of 0.001% to 1% is considered by the Court to be different than and to only slightly overlap a range of between 0.5% and 3%, the prior art range in the instant case, namely about 0.5% to 1.5%, which does not share any common values with the claimed range of “2% to 30%”, may not be characterized as overlapping, touching or within the claimed range. Moreover, since there are no overlapping or touching values between the prior art range and the claimed range, no reasonable fact finder could determine that Clarke describes the entire claimed range with sufficient specificity to anticipate this limitation of the claim.

Thus, for at least the foregoing reasons, the Examiner has not established that Clarke teaches at least this element of claim 1. Since each and every element of the claim is not found within the reference, anticipation may not be established. In view of the foregoing, Applicant respectfully requests reconsideration and withdrawal of the rejection of claim 1 under 35 U.S.C. §102.

In regard to claims 4, 5, 7 and 13, these claims depend from claim 1 and incorporate the limitations thereof. Thus, for at least the reasons that claim 1 is not anticipated by Clarke, claims 4, 5, 7 and 13 are further not anticipated by the reference. In view of the foregoing, Applicant respectfully requests reconsideration and withdrawal of the rejection of claims 4, 5, 7 and 13 under 35 U.S.C. §102.

II. Claim Rejections – 35 U.S.C. §103

A. In the outstanding Action, the Examiner rejects claims 1, 4, 6-9 and 11-15 under 35 U.S.C. §103(a) as being unpatentable over U.S. Patent No. 6,709,773 issued to Espinoza (“Espinoza”) in view of “Cosmetic and Toiletry Formulations, 1997” (“Flick₁”). Applicant respectfully traverses the rejection.

To establish a *prima facie* case of obviousness, the Examiner must show that the cited reference teaches or suggests each of the elements of a claim. Hindsight reconstruction may not be used to modify the reference to meet the claimed invention. MPEP § 2145. Furthermore, the fact that the claimed invention is within the capabilities of one of ordinary skill in the art, without some showing of an objective reason for modifying the reference to arrive at the claimed invention, is not sufficient to establish a *prima facie* case of obviousness. *In re Kotzab*, 217 F.3d 1365, 1371, 55 USPQ2d 1313, 1318 (Fed. Cir. 2000).

In regard to independent claim 1, the references fail to teach or suggest at least the elements of “the amount of silicone present in the composition is 2% to 30% by weight”, “a polymer viscosity modulator” and “wherein the composition has a pH in a range of 2.8 to 3.2” as recited in claim 1.

The Examiner fails to point to a portion of either Espinoza or Flick₁ teaching or suggesting each of these elements. In fact, with respect to the “polymer viscosity modulator” the Examiner admits Espinoza and Flick₁ fail to teach this element. See Action, page 5. Thus, if the Examiner chooses to maintain the rejection of claim 1 on this basis, Applicant respectfully requests the Examiner identify a portion of the references teaching each of these elements.

Similarly, in regard to independent claim 15, the Examiner fails to identify a portion of either Espinoza or Flick₁ teaching or suggesting at least the element of “a pH of less than 3.5.” If the Examiner chooses to maintain the rejection of claim 15 on this basis, Applicant respectfully requests the Examiner identify a portion of the references teaching this element.

Moreover, the Examiner's rejection of claims 1 and 15 on this basis must fail for at least the reason that the Examiner has improperly combined the references. In particular, the Examiner has failed to set forth where within the references the requisite motivation for combining the references is found. Thus, for at least the reason that the references may not be combined, claims 1 and 15 are not *prima facie* obvious over Espinoza in view of Flick₁. In view of the foregoing, Applicant respectfully requests reconsideration and withdrawal of the rejection of claims 1 and 15 under 35 U.S.C. §103(a).

In regard to claims 4, 6-9 and 11-14, these claims depend from claim 1 and incorporate the limitations thereof. Thus, for at least the reasons that claim 1 is not *prima facie* obvious over Espinoza in view of Flick₁, claims 4, 6-9 and 11-14 are further not obvious in view of the references. For at least the foregoing reasons, Applicant respectfully requests reconsideration and withdrawal of the rejection of claims 4, 6-9 and 11-14 under 35 U.S.C. §103(a).

B. In the outstanding Action, the Examiner rejects claim 10 under 35 U.S.C. §103(a) as being unpatentable over Espinoza in view Flick₁ as applied to claims 1, 4, 6-9 and 13-15 as above, and further in view of "Cosmetics Additives, 1991" ("Flick₂"). Applicant respectfully traverses the rejection.

Claim 10 depends from claim 1 and incorporates the limitations thereof. Thus, for at least the reasons discussed in regard to claim 1, neither Espinoza nor Flick₁ may be relied upon to teach or suggest at least the elements of "the amount of silicone present in the composition is 2% to 30% by weight", "a polymer viscosity modulator" and "wherein the composition has a pH in a range of 2.8 to 3.2" as further found in claim 10. The Examiner has further not pointed to, and Applicant is unable to discern a portion of Flick₂ curing the deficiencies of Espinoza and Flick₁ with respect to at least the elements of "the amount of silicone present in the composition is 2% to 30% by weight" and "wherein the composition has a pH in a range of 2.8 to 3.2." If the Examiner chooses to maintain the rejection of claim 10 on this basis, Applicant respectfully requests the Examiner identify where within the references each of these elements are found. For at least the foregoing reasons, claim 10 is not *prima facie* obvious over Espinoza in view Flick₁ and further in view of Flick₂. In view of the foregoing, Applicant respectfully requests reconsideration and withdrawal of the rejection of claim 10 under 35 U.S.C. §103(a).


CONCLUSION

In view of the foregoing, it is believed that all claims now pending, namely claims 1 and 4-15, are now in condition for allowance and such action is earnestly solicited at the earliest possible date. If there are any additional fees due in connection with the filing of this response, please charge those fees to our Deposit Account No. 02-2666. Questions regarding this matter should be directed to the undersigned at (310) 207-3800.

Respectfully submitted,

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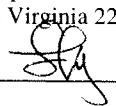
Dated: October 25, 2006

By: 
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CERTIFICATE OF TRANSMISSION

I hereby certify that this correspondence is being transmitted electronically to: Mail Stop Amendment, Commissioner for Patents, P.O. Box 1450, Alexandria, Virginia 22313-1450 on October 25, 2006.


Si Vuong